

REMARKS

Claims 1-7 are presently pending in this application. Claims 1, 4 and 7 have been amended to more particularly point out and distinctly claim the subject matter of the present invention. The amendments are fully supported by the specification. New claims 8-15 have been added. Support for the new claims is found, *inter alia*, at page 6, lines 15-20 and page 19, examples 3 and 4. No new matter is added.

Rejections Under 35 U.S.C. §102(b)

The Examiner has rejected Claims 1-7 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,990,341 to Goldie *et al.* (“Goldie”). Applicants respectfully traverse these rejections.

The legal test for anticipation under 35 U.S.C. § 102 requires that each and every element of the claimed invention be disclosed in a prior art reference in a manner sufficient to enable one skilled in the art to reduce the invention to practice, thus placing the public in possession of the invention. *W.L. Gore Associates v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) cert. denied 469 U.S. 851 (1984); *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985). Anticipation under 35 U.S.C. § 102 requires identity of invention. *Scripps Clinic & Research Fdn. v. Genentech Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Applicants respectfully submit that Goldie does not teach or suggest each and every element of claims 1-7. Specifically, applicants submit that the present claims do not relate to controlled release hydromorphone compositions as disclosed by Goldie, but instead relate to a process for the preparation of a controlled release oxycodone hydrochloride oral dosage form. The active agent disclosed in Goldie is hydromorphone or a salt of hydromorphone. Goldie does not disclose the use of oxycodone hydrochloride.

In sum, the art cited does not teach or suggest a process for the preparation of a controlled release oxycodone hydrochloride oral dosage form, as is disclosed and taught in the present case. Accordingly, applicants respectfully request that the rejections under 35 USC § 102(b) be withdrawn.

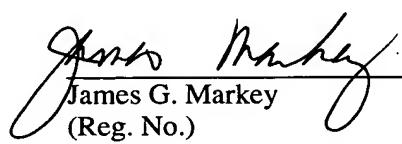
CONCLUSION

Entry of the foregoing remarks and amendments is respectfully requested. No fees beyond those for the extension of time are believed to be due with this Amendment. However, if any fee is required, please charge the fee to Jones Day Deposit Account No. 503013.

Respectfully submitted,

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